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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/069,999

03/01/2002

Takashi Kawasuji

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01/22/2009

WENDEROTH, LIND & PONACK, L.L.P.

2033 K STREET N. W.

SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

WESSENDORF, TERESA D

ART UNIT

PAPER NUMBER

1639

MAIL DATE

DELIVERY MODE

01/22/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/069,999	<b>Applicant(s)</b> KAWASUJI ET AL.	
	<b>Examiner</b> TERESA WESSENDORF	<b>Art Unit</b> 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***DETAILED ACTION***

***Reassignment of application***

Please note the reassignment of the application to the examiner below.

***Status of the Claims***

Claims 7-14 are pending and under examination.

Claims 17-23 have been canceled.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Withdrawn Rejection***

In view of the amendments to the claims the 35 USC 112, first paragraph (written description) rejection is withdrawn.

***Claim Rejections - 35 USC § 112, second paragraph***

Claims 7-14, as amended, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for reasons of record and reiterated below.

For claim 7, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since

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the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 7 recites the broad recitation "R9 each is independently .. substituted alkyl" (e.g., see claim 7, line 14), and the claim also recites "R9 each is independently ... halogenated alkyl" which is the narrower statement of the range/limitation because a "substituted" alkyl would encompass a "halogenated" alkyl.

### ***Response to Arguments***

Applicants assert that the Examiner has misunderstood the claim language. Specifically, "halogenated alkyl" is referring to "Y", rather than to "R9". This is evident by the use of the ";" after the phrase "optionally substituted alkyl".

In reply, the claim is confusing since for each of the definitions for Y a "-" (dash) mark precedes said Y definitions, which are missing for the alleged halogenated alkyl or optionally substituted heteroaryl. It is suggested that applicants insert said "-" mark as similarly done for the other definitions of Y e.g., phospho or sulfo groups, to avoid any confusion.

***Claim Rejections - 35 USC § 112, first paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

***New Matter Rejection***

Claims 7-14, as amended, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 7 which recites "with a proviso that the compound wherein X is hydroxy, Y is  $-P(O)(OR_9)Z$ , wherein  $R_9$  is ethyl, Z is hydrogen,  $ZI$  and  $Z3$  are bonds,  $Z2$  is  $-O-$  and  $RI$  is phenyl is excluded" is not supported in the as-filed specification.

Applicants assert claim 7 has been amended to exclude a particular compound. And, that no new matter has been added to the application by the amendment, since each of the recited substituent definitions in the exclusion was recited in the previously presented claim.

In reply, a review of the previously presented claims do not provide for said exclusion of the particular compound as recited supra. MPEP 714.02 clearly states that applicants specifically point out where support for new claim (negative)limitations is found in the original disclosure, e.g., in the previous claims as stated above.

***Claims Rejections - 35 U.S.C. 102***

Claims 7, 10, 11, 13, and 14, as amended, are rejected under 35 U.S.C. 102(b) as being anticipated by Maier et al. (Maier et al. "Organic Phosphorous Compounds. Synthesis and Properties of 1- Amino-2-Aryl and 2-Pyridyl-ethylphosphonic Acids and Derivatives" Phosphorus, Sulfur Silicon Relat. Elem. 1991,

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62, 15-27) for reasons advanced in the last Office action as reiterated below.

For claim 7, Maier et al. (see entire document) disclose the following compound: o (e.g., see Maier et al., last entry on Table II wherein 1-hydroxyl-2-(6-phenoxy-pyridin-2-yl)-vinyl-phosphonic acid diethyl ester is disclosed in 100% enol form; see also last entry in Table III wherein the corresponding oxime is disclosed; see also scheme II showing example of keto-enol transition; Beilstein Registry Number 4820019), which anticipates the claimed invention wherein X = OH; Y = -P(=O)(OR<sub>9</sub>)<sub>2</sub> wherein R<sub>9</sub> is ethyl (i.e., optionally substituted alkyl); Z = hydrogen; A = pyridine; Z<sub>3</sub> = bond; Z<sub>2</sub> = -O- ; R = phenyl (i.e., optionally substituted aryl). For claims 10 and 11, Maier et al. disclose pyridine, which is an optionally further substituted aromatic heterocycle containing a nitrogen atom.

For claim 13 and 14, Maier et al. disclose Z<sub>1</sub>/Z<sub>3</sub> = bond and R<sub>1</sub> = phenyl (i.e., optionally substituted aryl) and A is pyridine.

### ***Response to Arguments***

Applicants assert that specifically, the compound taught by Maier et al. is no longer encompassed by Applicants' claims.

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In reply, since the as-filed specification does not preclude the compound of Maier hence, the species of Maier anticipates the broad claimed compound.

No claim is allowed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TERESA WESSENDORF whose telephone number is (571)272-0812. The examiner can normally be reached on flexitime.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Schultz can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TERESA WESSENDORF/  
Primary Examiner, Art Unit 1639

<b><i>Application Number</i></b> 	<b>Application/Control No.</b>	<b>Applicant(s)/Patent under Reexamination</b>	
	10/069,999	KAWASUJI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	TERESA WESSENDORF	1639	